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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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10/529,502

03/28/2005

Gabi Muller

12810-00039-US

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03/12/2008

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EXAMINER

ROGERS, JAMES WILLIAM

ART UNIT

PAPER NUMBER

1618

MAIL DATE

DELIVERY MODE

03/12/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

|                              |                                      |                                      |  |
|------------------------------|--------------------------------------|--------------------------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/529,502 | <b>Applicant(s)</b><br>MULLER ET AL. |  |
|                              | <b>Examiner</b><br>JAMES W. ROGERS   | <b>Art Unit</b><br>1618              |  |

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 02/12/2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 6 and 8-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 6 and 8-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

Applicants amendments to the claims filed 02/12/2008 has been entered.

Applicants have amended claims 6 and 12 and added new claims 14-24.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 14-20 and 23 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Specifically the above new claims all recite either a) monomer D is present in an amount of no more than 5 wt% and b) E is present in an amount of not more than 10, the examiner could not find support within the specification for these new limitations. The only passage within applicant's specification the examiner could find for the amounts of monomer D was at paragraph [0102] of US 20050281774 A1 the US publication of applicants application, which stated the amounts of monomer D could be 0-10 wt% or 0-5 wt% or most preferably 0-2 wt%. The only passage within US 20050281774 A1 on the amount of monomer E the examiner could find was from 0-10 wt % at [0026]. Thus applicants do not have written support to claim that monomers D and E must be present because in every instance within the

specification the monomers were always listed in a range that included zero, thus the monomers were clearly optional components.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 6 and 10- 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hossel et al. (US 2001/0021375 A1, cited previously), a new rejection of claims 14-24 was necessitated by amendment.

Hossel was described previously in the office action filed 09/12/2007. Regarding new claims 14 and 16, Hossel discloses the use of 0-50 wt % of monomer (c) within the copolymer that is an unsaturated carboxylic acid including acrylic and methacrylic, thus monomer (c) of Hossel meets applicants claimed monomer D of claim 16. See [0011] and [0042]. Regarding claims 15 and 17-20 which require the presence of monomer E, Hossel discloses the use of 0-10% by weight of monomer (e) that can comprise an alkylated fatty acid eg a fatty acid reacted with poly(ethylene oxide) with 3-150 ethylene oxide units, the ethylene oxide would meet the limitation of a polyether containing compound. See [0011] and [0042],[0046]. Within the broad range of weight percents of monomers c) and e) above it is obvious that one of ordinary skill could select the weight percents claimed by applicants for monomers D and E. One with skill in the art would be motivated to optimize the molar concentration of the monomers within the copolymer of Hossel through routine experimentation to adjust the properties of the copolymer, which was said to stabilize the cosmetic preparation. Also the ranges for the above monomers of Hossel overlap the weight ranges claimed by applicants. It is a prima facie case of obviousness typically exists when the ranges of a claimed composition overlap the ranges disclosed in the prior art. E.g., In re Geusler, 116 F.3d 1465, 1469, 43 USPQ2d 1362, 1365 (Fed. Cir. 1997); In re Woodruff, 919 F.2d 1575, 1578, 16 USPQ2d 1934,

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1936-37 (CCPA 1976); In re Malagari, 449 F.2d 1297, 1202, 182 USPQ 549, 553 (CCPA 1974). It is the normal desire of scientists or artisans to improve upon what is already generally known provides the motivation to determine where in a disclosed set of percentage ranges is the optimum combination of percentages. See In re Boesch, 617 F.2d 272, 276, 205 USPQ 215, 219 (CCPA 1980) (“[D]iscovery of an optimum value of the result effective variable in a known process is ordinarily within the skill of the art.” See, e.g., In re Baird, 16 F.3d 380, 29 USPQ2d 1550 (Fed. Cir. 1994); In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). *In re Paterson* Appeal No. 02-1189 (Fed. Cir. January 8, 2003). Regarding claims 21-23 the vinylimidazole disclosed within Hossel overlaps the scope of applicants newly claimed vinylimidazole. See [0023]-[0024]. Regarding claim 24 which contains the transitional phrase “consisting essentially of” when referring to the components of the cosmetic composition, while Hossel discloses the use of at least one polyoxyethylene not present within applicants claims since the composition of Hossel was used for cosmetic purposes the polyoxyethylene is not precluded from applicants claimed cosmetic composition. The transitional phrase “consisting essentially of” limits the scope of a claim to the specified materials or steps “and those that do not materially affect the basic and novel characteristic(s)” of the claimed invention. Since applicants claims are drawn to a cosmetic composition as are the compositions of Hossel the extra ingredient of a polyoxyethylene is not precluded by applicant’s claims.

### ***Response to Arguments***

Applicant's arguments filed 02/12/2008 have been fully considered but they are not persuasive. Applicants assert that the polymers of Hossel are employed exclusively in quarternized form, thus applicants surmise the teachings of Hossel would not have allowed one of ordinary skill in the art to choose nonquarternized polymer.

The relevance of this assertion is unclear. Applicants do not claim an unquarternized copolymer instead they claim a copolymer consisting essentially of monomers A-C. There is no mention on whether these monomers are in quarternized or unquarternized form, therefore even if Hossel's polymer are only in quarternized form, the 103(a) rejections over '375 still stands. A quarternized polymer is still a polymer and applicant's currently amended claims do not preclude quarternized polymers. The transitional phrase "consist essentially of" does not preclude the use of quarternized (charged polymers) since there is no proviso that the polymers are uncharged. The transitional phrase "consist essentially of" only excludes materials within the composition that would materially affect the basic and novel feature of the composition.

Claims 6 and 8-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hossel et al. (US 2001/0021375 A1, '375 from hereon) in view of Hossel et al. (US 6,191,188 B1, cited previously, '188 form here on). A new rejection for claims 14-24 was necessitated by applicant's amendments to the claims.

'375 is disclosed above and in the previous office action filed 09/12/2007. Thus from the remarks by the examiner above all of applicants newly entered claims are met by the combination of '375 and '188.

### ***Response to Arguments***

Applicant's arguments filed 02/12/2008 have been fully considered but they are not persuasive. Applicants assert that their claimed weight range for the monomers is narrower than the range of '188 and the claimed ratio of monomer C to monomer B also is out of range. Applicants assert that monomer C is exclusively in non-quarternized form while Hossel prefers to use VI in quarternized form; applicants assert their transitional phrase "consists essentially of" precludes quarternized monomers.

The relevance of these assertions is unclear. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). '188 was combined with '375 to merely show that copolymers comprising N-vinylimidazole, N-vinylcaprolactam and N-vinylpyrrolidone were already well known at the time of the invention to be used in cosmetic hair compositions such as hair setting and styling compositions, thus as recited within the previous office action applicants intended use for their claimed copolymer would have been obvious.

### ***Conclusion***

No claims are allowed at this time.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, THIS ACTION IS MADE FINAL. See MPEP §706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).




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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James W. Rogers, Ph.D. whose telephone number is (571) 272-7838. The examiner can normally be reached on 8:30-5:00. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mike Hartley can be reached on (571) 271-0616. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Michael G. Hartley/  
Supervisory Patent Examiner, Art Unit 1618

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|--|-------------------------|---|--|
| <div>Application Number</div> <div></div> | Application/Control No. | Applicant(s)/Patent under Reexamination |  |
|  | 10/529,502              | MULLER ET AL.                           |  |
|  | Examiner                | Art Unit                                |  |
|  | JAMES W. ROGERS         | 1618                                    |  |